

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Paul T. Matsudaira, Daniel J. Ehrlich, Qiuhiu Zhong and Yelena Freyzon

Application No.: 09/627,383

Group: 1641

Filed: July 28, 2000

Examiner: L. V. Cook

Confirmation No.: 3215



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For: Affinity Fluorescent Proteins and Uses Thereof

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REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Responsive to the Restriction Requirement dated April 22, 2003, the claims of Group II (Claims 11-15), drawn to an affinity fluorescent protein expression cassette/vector a modified GFP and a nucleic acid sequence operatively linked to an expression control sequence comprising a modification between (Gln) 157 and (Lys) 158 and/or between (Glu) 172 and (Asp) 173, are elected for prosecution. Applicant reserves the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicant does not hereby abandon or waive any rights in the non-elected inventions.

The requirement is being traversed for the reasons set forth in detail below.

An extension of time to respond to the Restriction Requirement is respectfully requested. A Petition for an Extension of Time and the appropriate fee are being filed concurrently.

Traversal

The subject application was originally filed with Claims 1-26. A first Restriction Requirement requiring restriction among 5 groups of claims issued August 28, 2001 in the subject application (U.S. Patent and Trademark Office (PTO) paper no. 7). In response to the first Restriction Requirement, Applicants elected Group II (Claims 11-15) for prosecution.

The present Restriction Requirement is the second Restriction Requirement in the subject application (U.S. PTO paper no. 17). The second Restriction Requirement is the same as the first Restriction Requirement except that Claims 27-29 were placed in new Group VI. Claims 27-29 were added in the Amendment mailed to the U.S. Patent and Trademark Office on May 6, 2002 in response to the first Office Action on the merits (U.S. PTO paper no. 9, mailed from the U.S. PTO on November 6, 2001). After Claims 27-29 were added, the Examiner issued a second Office Action on the merits in which Claims 27-29 were searched, examined and rejected under 35 U.S.C. §112, first paragraph and 35 U.S.C. §103(a) (U.S. PTO paper no. 12, mailed from the U.S. PTO on November 6, 2001). However, *after* Claims 27-29 were examined on the merits along with the elected Group II claims, the second Restriction Requirement issued.

As noted in the MPEP,

37 CFR 1.142(a), second sentence states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required (MPEP, 8th edition, section 811, emphasis added).

Thus, although the Examiner has deemed that Claims 27-29 are patentably distinct from the claims being presently examined, there clearly cannot be a serious burden on the Examiner if restriction is not required, since the Examiner has searched, examined and rejected Claims 27-29 along with the previously elected Group II claims.

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Based on the above discussion, Applicant respectfully requests reconsideration and withdrawal of the present restriction requirement.

Respectfully submitted,

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